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09/629,746	07/31/2000	Louis Brown Abrams	D.N.7158	4116

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EXAMINER

LEE, EDMUND H

ART UNIT PAPER NUMBER

1732

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/629,746

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 and 54-69 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10, 15, 34 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 11-14, 16-33, 35-40 and 54-69 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18, 19, 21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Applicant's election of claims 1-5, 7, 8, 9-, 11-13, 14, 16-21, 22-33, and 35-40 in Paper No. 20 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 6, 10, 15, 34, and 41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 20.
3. The information disclosure statement filed 5/6/03 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.
4. The information disclosure statement filed 1/14/03 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but

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the information referred to therein has not been considered. A PTO-1449 listing the information is missing.

5. Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The base claim already teaches the limitations of claim 19.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "said step of forming said barrier" (cl 9,ln 1) lack antecedent basis in the claim. The step of forming a barrier was deleted by the amendment filed 5/2/03.

Clarification and/or correction is required.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1-5, 16-18, 54, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al (USPN 5053179) in view of Abrams (WO 90/09289). In regard to claim 1, Masui et al teach the basic claimed process including a process for producing a multi-layered molded article (figs 3-5d); providing a transfer film/skin material (figs 3-5d); positioning the transfer film against an interior wall of a mold in which the article is made (figs 3-5d); molding a part/substrate such that resin contacts a surface of the film to form a molded article (figs 3-5d); cooling the mold (col 6, lns 15-18); and ejecting the molded article (col 6, lns 15-18). Masui et al also teach using a transfer film comprised of fabric or non-woven fabrics (col 5, lns 15-21). However, Masui et al does not teach using the claimed transfer; and molding the substrate such that the resin contacts the layer of permanent adhesive, wherein the temperature of the resin is less than a melting point of the permanent adhesive. Abrams teach using a flock appliqué having a flocking layer, a release sheet on one side of the flocking and a layer of a permanent adhesive on an opposite side of the flocking to adhere to a surface of an article (pg 11, lns 17-30; figs 1-2); and using a cross-linked binder adhesive as the permanent adhesive (pg 11, lns 25-30)--as a note, a cross-linked substance cannot be reshaped or melted to be reshaped. Masui et al and Abrams are combinable because they are analogous with respect to forming a decorative article having a transfer or appliqué. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the flock appliqué of Abrams in the process of Masui et al in order to form a decorative article having a flocked surface. As a note, the cross-linked adhesive of Abrams will not melt in the process of Masui et al. In regard to claim

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2, it is well-known in the insert molding art to use an adhesive to maintain the position of an insert in a mold. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to affix the release sheet of Masui et al (modified) to the mold of Masui et al with an adhesive in order to ensure the proper position of the transfer throughout the molding process. In regard to claim 3, it is well-known in the insert molding art to use a vacuum to maintain the position of an insert in a mold. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to affix the release sheet of Masui et al (modified) to the mold Masui et al by vacuum in order to ensure the proper position of the transfer throughout the molding process. In regard to claims 4-5, Masui et al teach preventing resin from entering interstitial spaces of the transfer film (figs 3-5d); and forming a dam around the perimeter of the transfer (figs 3-5d). In regard to claims 16-18, the above combination of Masui et al and Abrams teach the limitations. In regard to claim 54, Abrams teach using an adhesive that is free of hot-melt (pg 11, ln 17- pg 12, ln 5) thus the above combination of Masui et al and Abrams teach the claimed limitation. In regard to claim 66, it is well-known in the molding art to preform a transfer before placement into a mold for many reasons such as to assist in anchoring the transfer in the substrate or to form clean contact lines. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to preform the transfer of Masui et al (modified) into a nonplanar, three-dimensional shape in order to achieve the above results.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al (USPN 5053179) in view of Abrams (WO 90/09289) as applied to claim 4 above and

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further in view of Banfield et al (USPN 5922436). The above combined teachings of Masui et al and Abrams are incorporated hereinafter. Masui et al does not teach using a dam of adhesive built up around the periphery of the transfer film. Banfield et al teach insert molding a fastener into a substrate (figs 3-15); using a fastener having exposed hooks (fig 1); protecting the hooks from the molding material used to form the substrate by using a temporary encasement (figs 3-15)—as a note, this encasement constitutes the claimed dam of adhesive built up around the periphery of the transfer film. Masui et al (modified) and Banfield et al are combinable because they are analogous with respect to insert molding and using an insert having openings therein that require protection. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the encasement of Banfield et al in the transfer of Masui et al (modified) in order to protect the flock of Masui et al (modified) from the molding material of Masui et al.

10. Claims 8, 11-13, 14, 19-21, 55, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al (USPN 5053179) in view of Abrams (WO 90/09289). In regard to claim 8, Masui et al teach the basic claimed process including a process for producing a multi-layered molded article (figs 3-5d); providing a transfer film/skin material (figs 3-5d); positioning the transfer film against an interior wall of a mold in which the article is made (figs 3-5d); and molding a substrate such that resin contacts a surface of the film to form a molded article having a film permanently bonded to the substrate (figs 3-5d). Masui et al also teach using a transfer film comprised of fabric or non-woven fabrics (col 5, Ins 15-21). However, Masui et al does not teach

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coating a release sheet with a release adhesive; flocking flock into the release adhesive; and affixing the release sheet to the interior surface of a mold. Abrams teach using a flock appliqué having a flocking layer, a release sheet on one side of the flocking and a layer of a permanent adhesive on an opposite side of the flocking to adhere to a surface of an article (pg 11, lns 17-30; figs 1-2); coating the release sheet with a release adhesive (figs 1-2); flocking flock into the release adhesive by embedding a first end of the flock into the release adhesive to result in at least one pattern of flock arranged to form a predetermined design adhered to the release sheet (figs); applying the permanent adhesive to the opposite side of the flocking (figs 1-2); and using a cross-linked binder adhesive as the permanent adhesive (pg 11, lns 25-30)--as a note, a cross-linked substance cannot be reshaped or melted to be reshaped. Masui et al and Abrams are combinable because they are analogous with respect to forming a decorative article having a transfer or appliqué. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the flock appliqué of Abrams in the process of Masui et al in order to form a decorative article having a flocked surface. As a note, the cross-linked adhesive of Abrams will not melt in the process of Masui et al, i.e., there will be no liquefying and oozing out of the adhesive. In regard to claim 11, Masui et al teach injection molding molten resin into the mold (figs 3-5d). In regard to claim 12, Masui et al does not teach using two injection pressures. However, such is well-known in the molding art in order to ensure high quality composite articles. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject the resin of Masui et al at the

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claimed two pressures in order to achieve the above result. In regard to claim 13, Masui et al does not teach using a resin with a melting point lower than the release adhesive. Such is a mere obvious matter of choice dependent on the desired final product and material availability and of little patent consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, such material is well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a resin with a melting point lower than the release adhesive in order to ensure the integrity of the flocking. In regard to claim 14, the combination of Masui et al and Abrams teach the limitations. In regard to claim 19, the combination of Masui et al and Abrams teach the limitations. In regard to claim 20, Masui et al does not teach a film that crosslinks with the molded article. It is well-known in the molding art to bond a preform to a shaping material by crosslinking. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use crosslinkable material in the process of Masui et al (modified) in order to strengthen the bond of the flocking to the resin substrate. In regard to claim 21, the combination of Masui et al and Abrams teach the claimed limitations. In regard to claim 55, Abrams teach using an adhesive that is free of hot-melt (pg 11, ln 17- pg 12, ln 5) thus the above combination of Masui et al and Abrams teach the claimed limitation. In regard to claim 67, it is well-known in the molding art to preform a transfer before placement into a mold for many reasons such as to assist in anchoring the transfer in the substrate or to form clean contact lines. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made

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to preform the transfer of Masui et al (modified) into a nonplanar, three-dimensional shape in order to achieve the above results.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al (USPN 5053179) in view of Abrams (WO 90/09289) as applied to claim 8 above and further in view of Banfield et al (USPN 5922436). The above combined teachings of Masui et al and Abrams are incorporated hereinafter. Masui et al does not teach using a dam of adhesive built up around the periphery of the transfer film. Banfield et al teach insert molding a fastener into a substrate (figs 3-15); using a fastener having exposed hooks (fig 1); protecting the hooks from the molding material used to form the substrate by using a temporary encasement (figs 3-15)—as a note, this encasement constitutes the claimed dam of adhesive built up around the periphery of the transfer film. Masui et al (modified) and Banfield et al are combinable because they are analogous with respect to insert molding and using an insert having openings therein that require protection. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the encasement of Banfield et al in the transfer of Masui et al (modified) in order to protect the flock of Masui et al (modified) from the molding material of Masui et al.

12. Claims 57-65, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 560855524 A in view of Abrams (WO 90/09289). In regard to claim 57, JP 560855524 A teaches the basic claimed process including a method for producing a molded article (abstract; figs 1-6); providing a decorative insert (abstract; figs 1-6); positioning the insert in a part of a mold (abstract; figs 1-6); introducing a resin into the

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mold after closure of the mold while the insert is positioned in the closed mold (abstract; figs 1-6). However, JP 560855524 A does not teach using a flocked structure; and using a permanent adhesive that does not ooze out around the flock fibers. Abrams teaches a flock appliqué that can be applied to any type of material (pg 14, Ins 29-31); using a flock appliqué having a flocking layer with a plurality of flock fibers adhered to a permanent adhesive, a release sheet on one side of the flocking and a layer of a permanent adhesive on an opposite side of the flocking to adhere to a surface of an article (pg 11, Ins 17-30; figs 1-2); and using a cross-linked binder adhesive as the permanent adhesive (pg 11, Ins 25-30)--as a note, a cross-linked substance cannot be reshaped or melted to be reshaped. JP 560855524 A and Abrams are combinable because they are analogous with respect to decorating a substrate with an insert/appliqué. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the flock appliqué of Abrams for the insert of JP 560855524 A in order to diversify the product line of JP 560855524 A. As a note, the cross-linked adhesive of Abrams will not melt in the process of JP 560855524. In regard to claim 58, Abrams teaches the claimed limitations (pg 11, Ins 25-30) thus the above combination of JP 560855524 A and Abrams teach the claimed limitations. In regard to claim 59, such is taught by Abrams (pg 12, Ins 1-5) thus the above combination of JP 560855524 A and Abrams teach the claimed limitations. In regard to claims claim 60, such is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further,

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thermosetting polyester adhesives are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermosetting polyester adhesive as the permanent adhesive of JP 560855524 A (modified) in order achieve proper bonding of the flocking transfer to the molded substrate. In regards to claim 61, Abrams teaches the claimed transfer thus the above combination of JP 560855524 A and Abrams teach the claimed limitations. In regard to claim 62, such is taught by the combined teachings of JP 560855524 A and Abrams. In regard to claim 63, such is taught by the JP 560855524 A. In regard to claim 64, such is taught by Abrams at pg 11, lns 25-30 thus the above combination of JP 560855524 A and Abrams teach the claimed limitation. In regard to claim 65, such is taught by Abrams at pg 11, lns 25-30 thus the above combination of JP 560855524 A and Abrams teach the claimed limitation. In regard to claim 69, it is well-known in the molding art to preform a transfer before placement into a mold for many reasons such as to assist in anchoring the transfer in the substrate or to form clean contact lines. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to preform the transfer of Masui et al (modified) into a nonplanar, three-dimensional shape in order to achieve the above results.

13. Applicant's arguments with respect to claims 1-5,7,8,9,11-13,14,16-21,22-23,35-40, and 56-69 have been considered but are moot in view of the new ground(s) of rejection.

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14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 703.305.4019. The examiner can normally be reached on **MONDAY-THURSDAY FROM 9AM-4PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 703.305.5493. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7718 for regular communications and 703.305.3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.



EDMUND H. LEE

Primary Examiner

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8/11/03

EHL

August 11, 2003